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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,455	11/08/1999	CHRISTOPHER JAMES DANEK	435712000921	6666
36544	7590	05/13/2004		EXAMINER
BRONCUS TECHNOLOGIES, INC.				SHAY, DAVID M
BUILDING A8				
1400 N. SHORELINE BLVD.			ART UNIT	PAPER NUMBER
MOUNTAIN VIEW, CA 94043			3739	
DATE MAILED: 05/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/436,455	Danek <i>danek stay</i>
Examiner	Group Art Unit	
	3739	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on January 22, 2004.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 1-13, 18-75 & 79-95 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-13, 18-75 & 79-95 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other _____

Office Action Summary

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13, 18-75, 79-82, 85-89, and 95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no description of how to extract the temperature signal from a temperature sensor which is in electrical communication with the conductive leg nor tines with a distal joint.

Claims 53 and 95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 53 and 95 are substantial duplicates, thus any difference in scope there between is unclear.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 18-30, 38, 39, 41-50, 54-60, 66-70, 71, 7, 74, and 81-94 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Farley et al ('899).

See figures 2, 3, 6, 6a, and 8-11 and column 6, line 13 to column 19, line 6. The temperature sensor in the middle of leg 26 is considered inside some portions of the solder contacting one lead or the other and electrodes are considered separate attachments, and the voids allowing the legs to reach from the ring to the open space, are considered lumens.

Claims 1-33, 18-30, 35-43, 54-56, 61, 63-70, 72-75 and 79-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al ('899) in combination with Burnside et al. Farley et al ('899) teach a device claimed, as set forth above, as well as the equivalence of conductive electrodes on insulative legs and conductive electrodes on conductive legs. Burnside et al teach an energy transfer device which can have the claimed basket length (see column 40, lines 34-66); various numbers of legs (see Figure 7-9, 39A, 39 B, 40A and 55); various temperature sensor locations (see column 17 lines 5-30); wherein the attaching of Burnside et al is equivalent to soldering, welding, or adhesive bonding; has a polymeric heating element (see column 38, line 34-41); with each basket leg in a lumen (see Figures 40A and 40B); wherein the wall is reinforced by a metallic member (see Figure 71B); and a wire carrying current (see Figure 55). It would have been obvious to the artisan of ordinary skill to employ the leg, electrode and attaching structure of Burnside et al in the device of Farley et al since these are equivalents in the art, as shown by Burnside et al, or to employ the conductive legs, since these are equivalent to non-conductive legs as taught by Farley et al and to employ sterilization, the visualization system; locating the temperature detector between the leg and the resistively heated element; the use of D.C. current; forming the legs from a single sheet of stainless steel; to stop delivering energy if a temperature change is not detected and including an optical fiber and CCD, since these provide no unexpected result; and since they are not critical , thus producing a device such as claimed.

Applicant argues that the first paragraph rejection is improper. The examiner disagrees. The basis of the rejection is not that extracting data from e.g. thermistors is beyond the scope of one having ordinary skill in the art. The basis of the rejection derives from Ohm's Law: $V=IR$ -

the voltage across an element is equal to the current through the element multiplied by the resistance of the element. The legs, being of a conductive material, will have essentially zero resistance, since this is the nature of conductors. Therefore, placing the e.g. thermistor and/or the electrical leads thereof in electrical contact with the electrically conductive leg would clamp the voltage across the device or the conductors at zero, since this is the value of the resistance of the conductor, inserting this value into Ohm's Law yields a zero voltage. Since the data from thermocouples is due to the voltage thereacross, and since the voltage thereacross, when in electrical communication with a conductive leg, would always read zero, due to Ohm's Law, no temperature sensing would be achieved.

Regarding the rejection under 35 U.S.C. 102, Farley et al ('899) teaches legs which are fixedly attached.

Regarding the rejection under 35 U.S.C. 103, the examiner regards the teaching of the equivalence of various configurations e.g. conductive verses – non- conductive legs to be a motivation for combination. Regarding the specific arguments, claim 26 reads on the teachings of Farley et al ('899) since situating the thermocouple in the aperture of the leg (see figure 110 is clearly "attached to an inside of a first leg" as required by the claim. Regarding claim 39, firstly, substituting the conductive for the non-conductive leg in Burnside et al would enable the use of adhesive without comprising the function of the originally applied Farley et al reference.

Regarding claims 63 and 83, the examiner notes that claim 62 from which claim 63 depends requires that "the deployment member comprises a wire..." (emphasis added), since the deployment member of Burnside et al can include a wire running along it, this is considered to read on the claim. Similarly, with the configuration of claim 83 the deployment member of

Burnside et al as disclosed as e.g. a hypo tube and terminates in the hub which would be in electrical communication with the hub and, in turn, the conductive legs.

Claims 31-34 and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments with respect to claims 1-13, 18-75, 79-82, 85-89, and 95 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DI

April 7, 2004


DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330